



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,170	10/30/2001	Louis B. Rosenberg	IMMR-0027B	1999
60140	7590	12/10/2007		
IMMERSION -THELEN REID BROWN RAYSMAN & STEINER LLP				
P.O. BOX 640640				
SAN JOSE, CA 95164-0640				
EXAMINER				
BRIER, JEFFERY A				
ART UNIT		PAPER NUMBER		
2628				
MAIL DATE		DELIVERY MODE		
12/10/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/004,170	Applicant(s) ROSENBERG ET AL.	
	Examiner Jeffery A. Brier	Art Unit 2628	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 November 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see page 2.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 3. NOTE: The claim listing does not make any amendments to the claims.

Attached: interview summary PTOL-413

Response to Amendment

1. The response filed on 11/23/2007 made no amendments.

Response to Arguments

2. Applicant's arguments filed 11/23/2007 have been fully considered but they are not persuasive.

The argument on page 12 concerning the information disclosure statement has been noted but applicants request to have references filed on March 7, 2007 considered has no basis in the rules since 37 CFR 1.98 and MPEP 609.04(a) requires a list be provided by applicant

§ 1.98 Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

(i) The application number of the application in which the information disclosure statement is being submitted;

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials; and

(iii) A heading that clearly indicates that the list is an information disclosure statement.

**609.04(a) Content Requirements for an
Information Disclosure Statement [R-5]**

An information disclosure statement (IDS) must comply with the provisions of 37 CFR 1.98 as to content for the information listed in the IDS to be considered by the Office. Each information disclosure statement must comply with the applicable provisions of subsection I., II., and III. below.

**I. LIST OF ALL PATENTS, PUBLICATIONS,
U.S. APPLICATIONS, OR OTHER INFOR-
MATION**

Each information disclosure statement must include a list of all patents, publications, U.S. applications, or other information submitted for consideration by the Office.

Thus, the reference have been entered into to the file but according to the rules they have not been considered. MPEP 609.05(a)

**609.05(a) Noncomplying Information
Disclosure Statements [R-5]**

Pursuant to 37 CFR 1.97(i), submitted information, filed before the grant of a patent, which does not comply with 37 CFR 1.97 and 37 CFR 1.98 will be placed in the file, but will not be considered by the Office. Information submitted after the grant of a patent must comply with 37 CFR 1.501.

The argument on page 9 second paragraph is not persuasive in view of the numerous prior art considered by the Examiner during the prosecution of this

application, note the 892s and 1449s and note the numerous office actions with prior art rejections prior to the 5/03/2004 Notice of Allowance.

The argument spanning pages 9 and 10 and the following paragraph on page 10 is not persuasive in view of MPEP 2172.01 first and second paragraphs which states a 112 first paragraph rejection may be made when the claims lack essential steps and/or a 112 second paragraph rejection may be made when the claims fail to interrelate essential steps of the invention as defined by applicants in the specification in view of the lack essential of steps in the claim.

2172.01 Unclaimed Essential Matter[R-1]

A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.

In addition, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). >But see *Ex parte Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. 1965) (“[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result”); *Ex parte Huber*, 148 USPQ 447, 448-49 (Bd. Pat. App. 1965) (A claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes.).<

Note In re COLLIER, 158 USPQ 266 (C.C.P.A. 1968) which reviewed the Board's statement found at page 267

The board, referring to the examiner's "catalogue" rejection, said:

Since in connection therewith the examiner states that "There is no positive recitation of any structural cooperation among the elements listed", we construe this rejection as in fact based on the ground that the claim is incomplete, and therefore indefinite and in this way does not conform to the requirements of 35 U.S.C. 112.

And stated at page 268

The main fault we observe in claim 17 is indefiniteness in the sense that things which may be done are not required to be done. For example, the ferrule or connector member is crimpable but not required, structurally, to be crimped; the ground wire "means," which we take to be a piece of wire, is *for* disposition under the ferrule but is not required to be disposed anywhere; it becomes displaced *when* the ferrule is crimped but that may never be, so far as the language of claim 17 is concerned. These cannot be regarded as structural limitations and therefore not as positive limitations in a claim directed to structure. They cannot therefore be relied on to distinguish from the prior art. The decision of the board is affirmed.

A similar analysis was performed recently by the CAFC for means plus function claims in Biomedino LLC v. Waters Technologies Corp., 83 USPQ2d 1118 (Fed. Cir. 2007) where the claimed functional steps did not correspond to the specification's functional steps. Thus, the essential functional steps of the specification were not present in the claims. Also note 2007-1108 MAURICE MITCHELL INNOVATIONS, L.P., v. INTEL CORPORATION, DECIDED: September 24, 2007 and viewable at: <http://www.cafc.uscourts.gov/opinions/07-1108.pdf>

Also note MPEP 2173.02 and 2173.03.

The argument in the paragraph spanning pages 10 and 11 concerning 37 CFR 1.104 is not persuasive in view of the numerous prior art considered by the Examiner

during the prosecution of this application, note the 892s and 1449s and note the numerous office actions with prior art rejections prior to the 5/03/2004 Notice of Allowance.

The argument in the paragraph spanning pages 11 and 12 is not persuasive because as discussed above the 35 USC 112 second paragraph rejection is proper.

The argument in the paragraph spanning pages 12 and 13 is not persuasive because as discussed above the 35 USC 112 second paragraph rejection is proper.

For the above reasons the final rejection is main tained.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 2628

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/
Primary Examiner, Division 2628